

## REMARKS

The Examiner now rejects all pending claims of the present application as either being anticipated by U.S. Patent No. 5,657,381 to Hughes-Hartogs (claims 1-8 and 10-14) or unpatenatable over Hughes-Hartogs in view of U.S. Patent No. 5,657,381 to Henrick. Applicant respectfully traverses the rejections, and urges early allowance of the present application.

With respect to the anticipation rejection, Hughes-Hartogs discloses a method for the transmission of image data from a sender, in which a conventional fax transmission on an incoming BRI line is routed to a plurality of terminals 21-28. Each of the terminals has programmed into it one or more unique fax telephone numbers. When an incoming call on BRI line 16 is for a fax number associated with the system, one of the terminals 21-28 receives the call, associates the fax telephone number to which the call is directed with the appropriate fax machine, computer or other device 62-66, and routes the incoming fax to the appropriate device. The method disclosed for fax processing is entirely different from that of the present invention, and is not an anticipation thereof.

The Hughes-Hartogs methodology uses conventional fax transmissions, in which the fax machine to which an incoming fax is to be sent is defined and identified by the conventional telephone number associated with the fax machine. See, for example, the discussion of such telephone numbers and use set forth at column 4, lines 1-50 Hughes-Hartogs. The purpose of the Hughes-Hartogs invention is to allow routing, at a customer's premises, of such standard facsimile transmissions, using the telephone number for the intended fax recipient as the sole means of identifying the recipient and routing the fax thereto (or otherwise).

Claims 1 and 10 of the present application are the sole independent claims, and each include the step of “inserting at the location of the sender into a data transmission including an image format portion data identifying the address of the intended recipient of the image format portion of the transmission and message tracking data.” While the examiner asserts that such a step is disclosed in the Hughes-Hartogs’ disclosure, and references col. 5, lines 9-14 of the reference as disclosing such a step, Hughes-Hartogs **does not** include such a step, either at that point or anywhere else. While col. 5, lines 9-14 of Hughes-Hartogs talks about outward-bound facsimile transmissions from the Hughes-Hartogs apparatus, it discloses only that the included computers of the Hughes-Hartogs system make sure that the image portion is of a correct format. The designations G3 or G4, specifically referenced in the disclosure, relate to the format of the images. **and have nothing to do with the insertion of address-signifying data.** Note that Hughes-Hartogs itself states, at column 5, lines 13-14 “...by doing an **image conversion** (typically into G3 or G4 format)” (emphasis added).

Similarly, while column 7, lines 2-8 of Hughes-Hartogs talks about formatting an outgoing facsimile in a certain manner, it provides absolutely no teaching or suggestion that such formatting includes the insertion of data identifying the address of the intended recipient. Typically, “formatting” involves for example, the inclusion of a header page, making sure that the image page size is consistent, etc. Hughes-Hartogs is entirely silent with regard to possible insertion of address or message tracking data into the transmission. It must be emphasized that a conventional telephone number that is dialed by the sender, and which routes the call to the equipment associated with the telephone number, is not an insertion of data into the transmission. The present application makes it clear that the insertion is into the data being transmitted, not use

of a telephone number that is not received by the recipient but merely defines the recipient to the telephone system over which the data travels. The other functions disclosed by Hughes-Hartogs and provided with respect to an outgoing facsimile, which may include recording accounting information, facsimile length, destination, etc., remain solely internal to the transmission station. Thus, any such tracking data are **not** part of the facsimile being transmitted, but are merely record-keeping data at the point of origin.

Hughes-Hartogs is clear that its system is intended to operate with conventional faxes, and provides no alteration or data insertion into a fax transmission at the point of origin.

While the foregoing with respect to independent claims 1 and 10 also establishes that dependent claims 2-8 and 11-14, also rejected on an anticipation basis, are similarly not anticipated, the following presents further grounds for allowance of the dependent claims referenced:

With respect to claims 2 and 14, because there is no data insertion, Hughes-Hartogs does not teach the insertion of message tracking data comprising at least one of accounting audit and documentation data. Col. 7, lines 5-8 again reference information that is **maintained at the point of transmission** with respect to outgoing faxes. There is absolutely no teaching, nor even suggestion, of the alteration of the outgoing fax by the entry of such data into the fax transmission itself.

With respect to claim 3, Hughes-Hartogs does not disclose a step of processing message tracking data by the point of present facility. Hughes-Hartogs' fax server 50, while providing

accounting, date and time stamping, etc., is not disclosed as obtaining any of such information from embedded data in the received fax. Indeed, it utilizes the 3-digit address that has been originated by the sender of the fax (col. 5, lines 20-22) which is a 3-digit portion of the **telephone number** associated with the sending fax machine. See, col. 1, lines 20-25, discussing background art, where a telephone number in the form NXX-XDDD is a conventional format. The DDD digits comprise the “3-digit address” referenced at col. 5 lines 20-22.

Similarly, Hughes-Hartogs does not disclose the teachings of present claim 4, because it does not strip message tracking data from the data transmission. Once again, the accounting information compiled by the fax server is not identified as being generated during or incorporated in the fax transmission, but rather is conventional information associated with a standard fax, such as the telephone number of a transmitting party, the time received, the telephone number (address) of the intended recipient, and the like. Hughes-Hartogs offers no insight as to the insertion of data at the sender’s location into the fax transmission itself, which may be used for such purposes. Similarly, with respect to claim 5, while Hughes-Hartogs discloses sending a confirmation message, Hughes-Hartogs does not disclose sending the confirmation message to the **sender**. The examiner himself asserts that “the Fax document is emailed to the **recipient**”. Emphasis added.

With respect to claims 6 and 7, while Hughes-Hartogs discloses the further transmission of an incoming fax to a recipient by email, the address of the recipient is **not** inserted at the location of the sender. Hughes-Hartogs states only that the fax number associated with particular computers can be the same as an email address for the computers. Thus, the email address is not embedded in the received transmission but is external thereto.

With respect to claim 12, Hughes-Hartogs does not disclose methodology wherein a transmission from the sender to the point of present facility is in the form of an email transmission. The disclosure referenced by the Examiner (col. 5, lines 35-43) relates to passing the facsimile received by the fax server to a **recipient** in the form of an email. It does not teach or suggest an outward-bound facsimile transmission in which the initial data transmission from the **sender** to the intermediate point of presence facility is in the form of an email.

Claim 9, also dependent on claim 1, has been rejected as being unpatentable and obvious over Hughes-Hartogs in view of Henrick. As discussed above, Hughes-Hartogs clearly does not teach or suggest the requirement of claim 1, wherein address-identifying data is inserted into the data transmission itself. While Henrick does teach the generation and sending of a confirmation message to a sender, this teaching does not fill the void left by Hughes-Hartogs; neither reference teaches the insertion of data into the data transmission itself. Henrick '137 utilizes conventional dialing information, external to the data transmission, associated with a fax telephone call to capture the telephone number of the sending party and send a confirming message back to that telephone number.

The Examiner has also objected to claims 6 and 7, asserting that they are duplicate claims. The Examiner's attention is directed to the claims, wherein claim 6 is dependent on claim 1, while claim 7 is dependent on claim 4. Thus, claim 7 incorporates additional limitations not found in claim 6, and thus the claims are of differing scope.

During the course of prosecution of the present invention, a variety of references have been cited by the Examiner as anticipating or rendering obvious the present invention, and each of such references has subsequently been withdrawn, the claims remaining un-amended. Indeed, it appears that the references being cited are becoming farther afield, and indeed are no more relevant than references previously asserted and discarded. It is hoped that with the present Response prosecution of the application can be successfully concluded and the application be passed to allowance.

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**CERTIFICATE UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313 on March 29, 2007.

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